



PATENT  
Customer No. 22,852  
Attorney Docket No. 05725.0414-01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: )  
Roland DE LA METTRIE et al. ) Group Art Unit: 1751  
Application No.: 09/852,624 ) Examiner: Eisa B. Elhilo  
Filed: May 11, 2001 ) Confirmation No.: 5645  
For: OXIDISING COMPOSITION FOR )  
TREATING KERATIN FIBRES )

**Mail Stop Appeal Brief--Patents**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450  
Sir:

**REPLY BRIEF UNDER 37 C.F.R. § 41.41**

Pursuant to 37 C.F.R. § 41.41, Appellants present their Reply to the Examiner's Answer dated January 12, 2005. A Request for Oral Hearing is concurrently filed with this Reply Brief.

If any fees are required in connection with the filing of this paper that are not filed herewith, Appellants request that the required fees be charged to Deposit Account No. 06-0916.

I. **Response to Examiner's Answer**

Claims 30-46 are stand rejected under 35 U.S.C. §103(a) over Tomura et al. (U.S. Pat. No. 6,027,719) ("Tomura") in view of Lim et al. (U.S. Pat. No. 6,045,590) ("Lim") for the reasons of record. Examiner's Answer, pp. 3-4. Appellants note that claims 47-53 have been withdrawn by the Examiner as being allegedly drawn to a non-elected invention.

As an initial matter, Appellants disagree with Examiner's statement that "the three criteria [for a *prima facie* of obviousness] have been met, because all references are in the same [analogous] art in hair dyeing composition." Examiner's Answer, p. 6, II. 1-2. This statement is incorrect. It is true that for an Examiner to rely on a reference to support an obviousness rejection, the reference must be analogous to the field of endeavor at issue, in that the reference must be either in the applicant's field of endeavor or reasonably pertinent to the particular problem being solved by the invention. See *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992); M.P.E.P. § 2141.01(a). However, establishing a reference as analogous is a far cry from establishing a *prima facie* case of obviousness. To make a *prima facie* case, the Examiner still must show (1) that there exists some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings, (2) that there is a reasonable expectation of success, and (3) that all claim elements are disclosed by the prior art references. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2143. Since the Examiner has not met at least two of these three

criteria with respect to the present rejection, a *prima facie* case has not been established.

**A. The Examiner has Provided No Motivation for the Incorporation of the Anionic Surfactants of Lim into Tomura's Dyeing Composition**

First, the Examiner asserts that sufficient motivation exists to incorporate the anionic surfactants disclosed in Lim with the dyeing composition of Tomura because Lim teaches that "a combination of different surfactants can be used to [i]mpart particular viscosity and foaming properties." Examiner's Answer p. 6, ll. 3-13. Applicants disagree that this teaching in Lim provides any motivation at all, particularly when read in the broader context of the teachings of both Lim and Tomura. Tomura teaches a method that can be used to determine if uric acid solubility is maintained upon the addition of an ingredient, but nowhere does Tomura teach which anionic surfactants may be used in its compositions without destabilizing uric acid solubility, and clearly, as discussed at length on the record, Tomura's stable balance is very delicate and easily disturbed. As a result, it would not have been obvious to add Lim's anionic surfactants to Tomura just because Lim has a broad teaching about surfactants. The teachings of both references have to be considered.

Further, even if, for the sake of argument, it would have been obvious to try Lim's surfactants to determine if they do or do not destabilize uric acid solubilization (e.g., using Tomura's method), obvious to try is not the proper standard for establishing a *prima facie* case of obviousness. *In re O'Farrell*, 853 F.2d 894, 7 U.S.P.Q.2d 1673 (Fed. Cir. 1988). In other words, even if the anionic surfactants of Lim could provide "particular viscosity and foaming properties," they cannot be added to Tomura without

sufficient evidence regarding their effect on uric acid solubility in view of Tomura's cautions against adding additional ingredients. Appellants also remind the Examiner that he cannot propose a modification to the prior art that will render the prior art unsatisfactory for its intended purpose. See *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). Since one of ordinary skill in the art would have no way of knowing whether Lim's anionic surfactants would render Tomura unsatisfactory for its intended purpose without trying the surfactants out, the rejection is not proper for this reason alone.

**B. There would have been no Reasonable Expectation of Success in the Combination of Tomura and Lim**

Next, the Examiner argues that there would have been a reasonable expectation of success in combining Lim with Tomura. Examiner's Answer p. 6, ll. 3-15. The Examiner's position here is set forth as a conclusory statement, without any evidence or rationale whatsoever in support. Examiner's Answer p. 6, ll. 13-15. The Federal Circuit has consistently held that such conclusory statements, i.e., lacking the support of clear and particular evidence and/or particular findings, cannot be used to establish a *prima facie* case of obviousness. See *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999); *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000); *In re Lee*, 277 F.3d 1338, 1344-45, 61 U.S.P.Q.2d 1430, 1434-35 (Fed. Cir. 2002). The Court's admonitions are particularly pertinent in light of (1) Tomura's repeated cautionary statements that ingredients cannot be added unless they do not adversely affect uric acid solubilization, and (2) Tomura's lack of guidance as to

which ingredients would not adversely affect uric acid solubilization. *Infra* and Appeal Brief at pp. 10-11.

The Examiner further argues that there would have been a reasonable expectation of success because Tomura has found a new technique to stably solubilize uric acid and “according to the invention of [Tomura] surfactants such as **anionic surfactants can be used in the composition without affecting the [stable] solubilization of uric acid**” using Tomura’s new technique. Examiner’s Answer, p. 6, I. 16 to p.7, I. 4 (emphasis added). However, the Examiner’s statement that anionic surfactants can be added without affecting uric acid solubility is incorrect. Tomura makes no such claim and the Examiner has provided no citation and no evidence to establish the truth of his statement. In fact, as argued at length on the record, Tomura repeatedly cautions that additional ingredients, including anionic surfactants, are not to be added if they destabilize the solubilization of uric acid up to 2%, the primary objective of Tomura’s invention. For example, Tomura warns that other ingredients “can be appropriately added in so far as they do not adversely affect the [solubility of uric acid]”. Col. 3, II. 50-52. Also, Tomura describes that only after they had “intensively studied the behavior of uric acid in aqueous cosmetic composition[s]” did they find that uric acid could be solubilized up to 2%. Col. 2, II. 1-7. Appellants can find no statement in Tomura claiming that adding anionic surfactants to Tomura’s compositions can be accomplished without affecting the stable solubilization of uric acid. Indeed, the aforementioned statements of Tomura indicate the opposite; Tomura repeatedly warns against adding other ingredients because Tomura cannot predict how they would affect uric acid solubilization.

For these additional reasons, Appellants submit that the rejection over Tomura in view of Lim should be withdrawn.

**C. There would have been no Motivation to Choose an Anionic Surfactant from Lim in the First Place**

The Examiner additionally argues that because "Lim teaches three claimed anionic surfactants out a list of 23 anionic surfactants" there would have been motivation to choose one of those surfactants. Examiner's Answer, p. 7, ll. 5-14. First, to clarify, Lim's list is **not** composed solely of anionic surfactants; the list is in fact a mixture of cationic (e.g., quaternary ammonium salts), nonionic (e.g., sorbitan esters) and anionic surfactants. Lim, col. 9, ll. 39-65. Second, the Examiner has provided no motivation to pick Appellants' claimed anionic surfactants out of Lim's list of 23 surfactants. An Examiner is not permitted to pick and choose limitations without providing evidence to motivate or suggest his choice, and neither is he allowed to apply an obvious-to-try standard, as discussed above. *Ex parte Clapp*, 227 U.S.P.Q. 972 (Bd. Pat. App. & Inter. 1985); *In re Wesslau*, 147 U.S.P.Q. 391 (Bd. Pat. App. & Inter. 1965); M.P.E.P. § 2144. Since the Examiner here has provided no evidence of motivation or suggestion for the choice of surfactant (anionic or otherwise), the Examiner appears to improperly be using hindsight reconstruction with the Appellants' invention as the blueprint. However the Federal Circuit and its predecessor have long held that using the claimed invention as a blueprint to coble together prior art is improper. See *Grain Processing Corp. v. American Maize-Products Co.*, 840 F.2d 902, 5 U.S.P.Q.2d 1788 (Fed. Cir. 1988); *In re McLaughlin* 443 F.2d 1392, 170 U.S.P.Q. 209 (C.C.P.A. 1971); M.P.E.P. §§ 2143.01, 2145.X.A.

To further justify his choice of the instantly claimed anionic surfactants from Lim's list of 23, the Examiner cites *In re Sivaramakrishnan* for the proposition that "a reference that clearly names the claimed species **anticipates** the claim no matter how many other species are named in the reference." Examiner's answer, p. 7, ll. 13-14 (emphasis added) (citing *In re Sivaramakrishnan*, 673 F.2d 1383, 213 U.S.P.Q. 441 (C.C.P.A. 1982)). Yet *In re Sivaramakrishnan* is not on point because it speaks to anticipation, not to establishing a *prima facie* case of obviousness. *In re Sivaramakrishnan*, 673 F.2d 1383, 213 U.S.P.Q. 441 (C.C.P.A. 1982). If one used the Examiner's implied rationale that one need only find the limitations of the claimed invention "clearly named" in prior art references, then the Federal Circuit's requirement for motivation and reasonable expectation of success would be rendered useless. Indeed, as discussed above, the Federal Circuit has repeatedly forbidden examiners from using pick-and-choose rationales to establish a *prima facie* case of obviousness. Because the Examiner's argument provides no evidence to motivate or suggest the choice of Appellant's instantly claimed anionic surfactants from Lim's list of 23 surfactants, a *prima facie* case of obviousness cannot be established.

The Examiner also argues that Tomura "does not refer specifically to the anionic surfactants that adversely affect [Tomura's] invention as asserted by the appellants," and that other ingredients are mentioned in Tomura. Examiner's Answer, p. 7, ll. 15-21. The Examiner does not cite any particular statement in Appellant's Appeal Brief, so Appellants cannot respond specifically to Examiner's implication that Appellants disregarded the other ingredients. Appellants do not believe such a misrepresentation exists in the Appeal Brief, but if Appellants' arguments impliedly excluded other

ingredients and left the reader to believe that Tomura only discussed anionic surfactants, Appellants provide below, in full, the relevant paragraph from Tomura, in order to clarify and foreclose any possible misunderstandings:

In the present invention, according to the desired preparation form, **surfactants such as anionic surfactants**, cationic surfactants, nonionic surfactants, etc.; oily agents such as higher alcohols, higher fatty acids, paraffin wax, hydrocarbon oils, ester oils, silicone oils, etc.; hair dyes such as oxidation dyes, direct dyes, etc.; moisturizers such as glycerin, propylene glycol, etc.; thickeners; preservatives; anti-oxidants; UV absorbers; metal chelating agents; enzymes such as uricase; various pharmacologically active ingredients; perfumes; **and the like can be appropriately added in so far as they do not adversely affect the present invention.**

Col. 3, ll. 41-52 (emphasis added). The most important aspect of this paragraph is that the cautionary ending (the last independent clause in boldface) modifies all aforementioned ingredients in the paragraph, including anionic surfactants. Moreover, the inclusion of other ingredients in the above paragraph does not diminish the applicability of Appellants' arguments: none of these ingredients can be added if they adversely affect uric acid stability. Aside from the few ingredients listed in Tomura's examples (none of which are anionic surfactants), Tomura does not teach which of the genus ingredients in the list (or which subgenus or species thereof) do or do not adversely affect uric acid stability, and the Examiner has provided no evidence for such a teaching.

Finally the Examiner argues that there is a contradiction in Appellants' arguments regarding whether the presence of anionic surfactants is required in Tomura's compositions. Examiner's Answer, p. 8, ll. 1-12. Appellants do not understand the

Examiner's argument here. Appellants have always contended that surfactant and anionic surfactants are not required in Tomura's compositions. The Tomura paragraph, provided in-full above, clearly indicates that neither surfactants nor anionic surfactants are required in the invention, just that they can be added only in so far as they do not destabilize uric acid solubilization. Claim 2 in Tomura is similarly restrictive but does not mention anionic surfactants. In fact none of Tomura's claims mentions anionic surfactants, even though dependent claim 15 limits the surfactants mentioned in independent claim 2 to cationic or nonionic. Thus, Appellants find no contradiction in the arguments presented, either now or previously, regarding Tomura's lack of a requirement for the inclusion of surfactants or anionic surfactants.

The Examiners states that "there is no suggestion in the record that one of ordinary skill would have any difficulty in understanding or following Tomura's teachings concerning the combination of anionic surfactants and uric acid in an aqueous composition." Examiner's Answer, p. 8, ll. 10-12. Appellants agree, but just because there is no suggestion that one of ordinary skill in the art would have difficulty understanding Tomura's teachings doesn't mean that those teachings are sufficient (1) to provide a reasonable expectation of success or (2) to provide motivation or suggestion to modify Tomura itself or combine Tomura with another prior art reference. As Appellants have repeated stated above and on the record, Tomura cautions against the addition of anionic surfactants (and other ingredients) because such additions could destabilize uric acid solubilization. The Examiner has provided no evidence that there is a reasonable expectation of success in overcoming Tomura's cautionary statements, and similarly has not provided sufficient motivation to combine Lim's surfactants with

Tomura's composition. As a result of these deficiencies, the Examiner has not established a *prima facie* case of obviousness.

## **II. Conclusion**

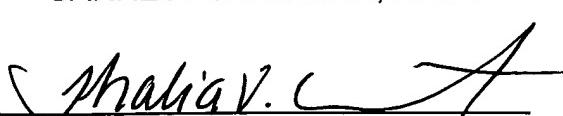
In summary, Appellants contend that the Examiner has not directly addressed at least one of Appellants' primary arguments, that Tomura repeatedly cautions against adding many ingredients (including anionic surfactants) due to their unknown effects on Tomura's self-stated requirement for stable solubilization of uric acid. This theme runs throughout Tomura as found, for example, in the paragraph from Tomura reproduced above, and in all of Tomura's independent claims. It provides an additional barrier for an affirmative finding of a reasonable expectation of success and the motivation to modify or combine with other references, neither of which is found here. The Examiner simply has not addressed Tomura's repeated cautions and thus, for at least this reason cannot establish a *prima facie* case of obviousness.

For this reason, for those aforementioned, and for those previously mentioned in the Appeal Brief, Appellants maintain that a *prima facie* case of obviousness has not been established by the Examiner. Accordingly, Appellants respectfully request reversal of the rejections of claims 30-46 under 35 U.S.C. § 103(a).

Respectfully submitted,

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Dated: March 14, 2005

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